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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/505,619	02/16/2000	Ronald A. Katz	251/002	6020

29129 7590 04/08/2003

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EXAMINER

GARG, YOGESH C

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 04/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/505,619

Applicant(s)

KATZ ET AL.

Examiner

Yogesh C Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02/16/2000-Preamendment, paper # 2 1/2.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 172-177 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 172-177 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☒ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☒ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 & 5. 6) ☐ Other:

### DETAILED ACTION

1. With reference to telephone discussions with the attorney Mr. David B. Murphy on March 21, 2003, it was confirmed that the Pre-amendment mailed on February 16, 2000 has been entered as paper # 2 ½. Since Pre-amendment was not considered in the earlier Office- action, paper #4, the same is being withdrawn and as well as the applicant's response to it, paper # 9 received on September 30, 2000 will not be considered. As per the Pre-amendment, claims 1-171 have been cancelled and new claims 172-177 have been added. Currently claims 172-177 are pending for examination. Terminal disclosure, paper #8, received on September 30, 2000 is acknowledged and entered.

### *Claim Objections*

2. Claims 172-177 are objected to because of the following informalities:

Regarding claims 172-177, the phrase "such as" used in the preamble of claim 172 renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). The examiner suggests to delete " such as a telephone, videophone or computer " to withdraw the objection to the claims 172-177. Appropriate correction is required.

### *Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 172-177 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-267 of U.S. Patent No. 6,055,513. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims concern a method for making upsell offer to a customer during a separate product transaction from which customer information has been collected for use in determining the upsell.

Note: Since a Terminal disclaimer, paper #8, has been received and entered on September 30, 2002; it can overcome the above-mentioned actual or provisional rejection.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 172-177 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (US Patent 6,196,458), hereinafter referred to as Walker, and further in view of Kenney (US Patent 6,381,583-reference provided in IDS, paper #5).

With reference to claims 172-177, Walker teaches a method for providing offers of an item constituting a good or a service to prospective customers as users comprising the steps of :obtaining primary transaction data with respect to the primary transaction, including the identity

of the prospective customer and of the purpose of the primary transaction, utilizing the identity of the prospective customer to obtain at least a second data element relating to the user, utilizing in part the primary transaction data including the purpose of the primary transaction and the second data element and determining at least one item for prospective upsell to the prospective customer which is different than the first good or service as well the upsell transaction is either different from the primary transaction like if upsell is a service transaction and primary transaction is a purchase transaction or both upsell and primary are same transactions or upsell transaction is a replacement transaction for the good purchased in the primary transaction, and offering the item to the prospective customer in lieu of the first good or service (see at least FIGS. 1-7, col.1, lines 59-63, "...provide methods and systems using automated, predetermined criteria...upsell offers for products..", col2, lines 56-67, "....to offer and sell products complementary to previously-purchased products to the account holder....offered product be related to previous purchases....", col.3, lines 4-19, "....for example, an account holder may buy a television, .....it is more convenient for the account holder to accept an offer.....for a warranty...", col.5, lines 8-20, "....Many types of upsells may be offered....for example, a warranty on a television.....", col.5, line 26-col.6, line 7, "...The central controller 12 determines upsells to offer each account holder based on previous transactions by the account holder.....", col.7, line 66-col.8, line 63, "...upsell offer is printed.....provided to the account holder....upsell was accepted...", col.9, lines 35-42, "...those skilled in the art will understand that various substitutions may be made to those embodiments....a great number of types of upsells and methods of providing those upsells will be apparent to those skilled in the art").

Walker teaches that the primary transactions relate to purchase of goods. Walker does not show that the primary transactions are communicated via an electronic communication

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device. However, the process of purchasing goods and services via Internet and world -wide - web is notoriously well known in the field of e-commerce at the time of the invention. Kenney teaches interactive electronic shopping via Internet and world- wide- web using an electronic communication device (see at least col.1, line 41-col.3, line 20). In view of Kenny, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to combine Walker and Kenny because Walker/Kenny combined would enable the user to shop interactively on Internet for benefits explicitly described in Kenny (see at least col.1, lines 8-38) and to provide upsell offers to the customers to generate additional sales to the users (see Walker col.1, lines 47-56).

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) US Patent 6,119,099 to Walker et al. teaches a method and a system for Upselling products at a point-of-sale terminal.

(ii) Tehrani, Nadji; " Hardware, software... humanware "; Telemarketing & Call Center Solutions; Norwalk; Sep 1997, vol.16,issue 3, pages 3, extracted from <http://proquest.umi.com> on 3/26/2003 teaches Upselling goods via Internet and world wide web (see page 2, under the head, " The Web of The Future").

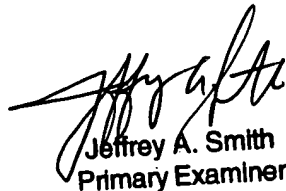
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F (8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Yogesh C Garg  
Examiner  
Art Unit 3625

YCG  
March 26, 2003



Jeffrey A. Smith  
Primary Examiner